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In the Supreme Court of the United States

October Term, 1964.

No. [redacted] 11

WILLIAM T. GRAHAM, AND GRAHAM PLOW, INC., *Petitioners,*

vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY, *Respondents.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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vs.

JOHN DEERE COMPANY OF KANSAS CITY, AND DEERE & COMPANY, *Respondents.*

PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, WILLIAM T. GRAHAM and GRAHAM PLOW, INC., pray that a writ of certiorari should issue to review the decree of the Court of Appeals for the Eighth Circuit entered on June 18, 1964 (R. Vol. V, p. 14) 333 F. 2d 529, petition for rehearing denied July 13, 1964 (R. Vol. V, p. 21).

Opinions of the Courts Below.

(a) Opinion of the District Court (R. 17-34) reported 216 F. Supp. 272.

(b) Opinion of the United States Court of Appeals for the Eighth Circuit in John Deere Company of Kansas City et al. v. William T. Graham et al., No. 17,441, dated June 18, 1964, (R. Vol. V. p. 1-14) reported in 333 F. 2d 529. Copies of the opinion, the judgment and the order overruling petition for rehearing are appended to this petition. (Appendix A, B, and C).

The patent here in suit has also been before other courts in the following cases:

(a) *William T. Graham et al.* v. *Jeoffroy Mfg., Inc., et al.* (D. C. Tex. N. D.) opinion not reported.

(b) *Jeoffroy Mfg., Inc. et al.* v. *William T. Graham et al.*, 5 Cir., 219 F. 2d 511, holding patent valid and infringed. Certiorari denied, 350 U. S. 826. (Appendix D)

(c) *Jeoffroy Mfg., Inc. et al.* v. *William T. Graham et al.* (D. C. Tex. N. D.) contempt proceeding, opinion not reported.

(d) *Jeoffroy Mfg., Inc. et al.* v. *Graham, et al.*, 256 F. 2d 360, (contempt affirmed). (Appendix E)

(e) *Graham* v. *Cockshutt Farm Equipment, Inc.*, (D. C. Tex. N. D.) opinion not reported.

(f) *Graham* v. *Cockshutt Farm Equipment, Inc.*, 5 Cir., 256 F. 2d 358, holding patent valid but not infringed. (Appendix F)

Jurisdiction.

1. This is a suit arising under the Patent Laws of the United States, Title 28, Section 1338, of the United States Code.

2. The jurisdiction of this Court is invoked under Title 28, Section 1254, of the United States Code.

3. The date of the decree which the petitioners seek to have reviewed is June 18, 1964. Petition for rehearing was denied July 13, 1964.

Question Presented.

The principal and we believe the sole question presented is the validity of the Graham patent No. 2,627,798. The District Court found infringement, but the Court of Appeals for the Eighth Circuit did not consider the question of infringement.

Constitutional and Statutory Provisions and Procedure Rule Involved.

This case involves Clause 8 of Section 8, Article I of the Constitution of the United States, and Sections 101, 102, 103 and 282 of Title 35 of the United States Code, and Federal Rule of Civil Procedure Number 52, all of which are set forth in Appendix G hereof.

STATEMENT OF THE CASE.

The patent in suit (R. 577), while entitled "Clamp for Vibrating Shank Plows", discloses and claims a structure mounting tool carrying shanks on mobile frames for working soil in what is termed "chisel plowing", and particularly for use in rocky areas where during plowing the structure is subjected to severe shocks by the tool striking rocks or immovable objects. Chisel tools are secured to the lower ends of the shanks and, when the structure is moved over the ground with the tools extending therein, said tools break the soil and form small alternate ridges and furrows having exposed surfaces and leaving vegetation and other emulsive material normally occurring on the field on top of the ground. In chisel plowing in the plains country wherein the ground was substantially free of rocks, the upper forward ends of shanks were rigidly secured to plow beams or frames, the shanks extending rearwardly therefrom and curving downwardly to the end mounting the chisel tool, and any resiliency or flexing of the shanks was only in the portions that extended rearwardly from the clamps. However, when such structures were used in the farming areas having rocky conditions, the plows were bent and broken and the structures were not satisfactory. When the plows are pulled through the ground by tractors and one of the tools on a shank strikes a buried rock, the structure may be subjected to extreme shocks. The forces on the chisel tool could result in forces on the forward ends of the shanks up to 4,000 pounds or so (R. 409). The invention provides a structure with an ability to flex for absorbing the shock so as to eliminate or reduce breakage or damage to the structure.

In the trial of this case before the District Court, the structures were shown and the Court was clearly advised in the premises. The District Court rendered a memorandum opinion and made findings of fact and conclusions of law. One of the findings held that with the structure of the patent an improved functional result is obtained. The Court also found that the combination of the patent was not obvious at the time Graham made his invention to a person having ordinary skill in the art of agricultural implements and other related arts. The Court of Appeals reversed the District Court's judgment and held the patent invalid and, in doing so, set forth its test of patentability. It also clearly stated that its test was different than that applied by the Court of Appeals of the Fifth Circuit wherein the patent had been held valid. There is a direct conflict of determination between the Court of Appeals for the Eighth Circuit in this case and the Court of Appeals for the Fifth Circuit in the cases of *Jeoffroy Mfg. Inc., et al.* v. *William T. Graham, et al.,* 219 F. 2d 515 (cert. denied 350 U. S. 826) and *Graham* v. *Cockshutt Farm Equipment, Inc.,* 256 F. 2d 358, in both of which cases the same patent was held valid. The Court of Appeals of the Eighth Circuit, while referring to the statute, did not apply the test of patentability provided therein.

Reasons for Granting the Writ.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the ground of the direct disagreement between the Court of Appeals for the Eighth Circuit, 333 F. 2d 529, and the Court of Appeals for the Fifth Circuit, 219 F. 2d 511 and 256 F. 2d 358, as to the validity of the Graham patent.

In accordance with the thoroughly established practice of this Court, such a conflict between the decisions of two

Courts of Appeals, particularly when coupled with the important question of Federal Law involved, constitutes special and important reasons for the grant of the writ as provided in Rule 19 (b) of this Court.

In almost all cases where a patent is twice litigated, there is additional evidence in the second case, but in this case there was no additional prior art presented over that which was considered by the Court of Appeals for the Fifth Circuit in the case of *Graham* v. *Cockshutt Farm Equipment, Inc.*, 256 F. 2d 358.

With the prior art the same, one Court of Appeals held the patent valid and the other Court of Appeals overturned the decision of the District Court and held the patent invalid. There is a fundamental difference between the two Courts of Appeals in their respective legal views as to the patent in suit.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the further ground that the decision of the United States Court of Appeals for the Eighth Circuit is a decision involving a question of Federal Law, namely, as to test of patentability that is contrary to that set forth in the Statute, Title 35, Section 103, of the United States Code. The test of patentability under the Statute is an important question of Federal Law which has not been, but should be, settled by this Court.

A further reason is that the decision of the Court of Appeals for the Eighth Circuit is a decision with respect to review of Findings of Fact by the District Court that is in conflict with the express provisions of Rule 52 of the Federal Rules of Civil Procedure; and is in conflict with the decisions of this Court upon that question, and is in conflict with the decisions of other Courts of Appeals.

ARGUMENT.

Direct disagreement as to the validity of a patent between Courts of Appeals of different circuits has invariably led to a review by this Court.

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.* (1911), 220 U. S. 428, 436, 437 (1911);
Permutit Co. v. *Graver Corporation* (1931), 284 U. S. 52;
Cuno Engineering Corp. v. *Automatic Devices Corp.*, (1941), 314 U. S. 84;
Automatic Devices Corp. v. *Sinko Tool & Manufacturing Co.* (1941), 314 U. S. 94;
The Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.* (1944), 321 U. S. 275.
United States v. *Carlos Muniz, et al.*, (1963), 374 U. S. 150.

This case presents a stronger justification for grant of the writ than the usual case wherein a patent has been litigated in different circuits. In almost every case where a patent is litigated a second time after adjudication in one circuit, the party accused of infringement attempts to augment the proofs of the first case so there is usually new evidence in the second case. However, in this case, all of the alleged prior art relied on by the defendants was before the Court and considered in the case that resulted in the decision of the Court of Appeals for the Fifth Circuit in which the patent in suit was held valid. *Graham* v. *Cockshutt Farm Equipment, Inc.*, 5 Cir., 256 F. 2d 358. The cases cited above are a few well known examples that would indicate justification for granting of the writ, even if there had been new evidence in the case here. This is even a stronger case; with exactly the same prior art, the Court of

Appeals for the Fifth Circuit held the patent valid, and the Court of Appeals for the Eighth Circuit held the patent invalid. This presents a clear conflict and direct disagreement that is believed to justify granting of the writ. The opinion of the Court of Appeals for the Eighth Circuit stated:

> "* * * To be patentable, a combination of individually old elements must contribute something new; the elements must cooperate to produce an accumulation which exceeds the sum of its parts. (Citing cases). Stated differently, 'the bringing together of old elements in a mechanism involving no new principle, to produce an old result, however skillfully done, even though the result marks an advance in efficiency and utility, is but an exercise of mechanical skill and not invention.' General Bronze Corp. v. Cupples Products Corp., 8 Cir., 189 F. 2d 154, 161 (1951).
>
> "Our task is to first ascertain whether the trial court applied the proper legal standard in determining the validity of Patent 798, and then to decide whether the patent satisfies the requirements of this test. At this point, we note that the 798 Patent has been held valid on two occasions in appeals before the Fifth Circuit. Jeoffroy Mfg., Inc. v. Graham, 219 F. 2d 511 (1955), cert. denied, 350 U. S. 826 (1955), and Graham v. Cockshutt Farm Equipment, Inc., 256 F. 2d 358 (1958).
>
> Unlike our court, the Fifth Circuit has 'long recognized . . . that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where . . . it produces an *old result in a cheaper and otherwise more advantageous way.*' (Emphasis supplied). 219 F. 2d at 519. For other recognition by the Fifth Circuit of the 'old result in a more efficient and economical way' see, Cornell v. Adams Engineering Company, supra, 258 F. 2d at 875-876."

This clearly shows a difference in approach, a direct disagreement as to the determination of patentability, which is an important question of Federal Law that should be settled by this Court.

The Test of Patentability Applied by the Court of Appeals for the Eighth Circuit is in Conflict with the Requirements of the Statute.

The Court of Appeals in this case refers to a standard of invention and throughout the opinion clearly shows that the test or standard applied by that Court is that the mechanism must produce a new result. It is submitted that this is in conflict with the Statute. It is submitted that the constitutional clause contains no standard for determining patentability that requires the invention produce a new result. As for the Statute, the Patent Act of 1952 sets out all of the requirements for patentability in the clearest possible form. 35 U.S.C. 101, 102 and 103. Section 101 says inventions must be new and useful. Section 102 defines novelty, and Section 103 sets forth the other requirement that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art. The last sentence of Section 103 clearly eliminated any requirement that the new device reveal a flash of creative genius which some courts required for validity after this Court's decision in the *Cuno Engineering Corp* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941). The Court of Appeals of the Eighth Circuit admittedly is applying tests or standards as to patentability based upon the decisions in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, and *The Great A & P Tea Co.* v. *Supermarket Equipment Corporation*, 340 U. S. 147 (1950). Both of said decisions were before the Patent Act of 1952 which now provides the rules that

should be followed in determining the patentability of the invention. It is believed that the decision in the present case being in conflict with the provisions of the Statute, 35 U.S.C. 101, 102 and 103, justifies the granting of the writ of certiorari.

The decision of the Court of Appeals for the Eighth Circuit is also in conflict with the express provisions of the Statute, 35 U.S.C. 282, which provides a patent shall be presumed valid. The Court of Appeals in its decision stated that the presumption of validity is weakened if applicable prior art is not considered by the Patent Office, but it ignored entirely the fact that all of the patents and prior uses relied on by the defendants that were not made of record in the Patent Office during the prosecution of the application for the patent were similar to some of the patents relied upon by the Patent Office examiner. The Patent Office cites examples of prior art. It would be impractical, repetitious and useless to cite and make a record of each and every prior art patent considered by the Patent Office examiner in his search of the prior art in locating the ones to be cited as examples. The mere fact that a defendant brings before the Court a prior patent or prior use that was not made of record in the Patent Office proceedings should not weaken the presumption of validity provided by the Statute unless the additional prior art is substantially different and more pertinent than that cited by the Patent Office. In this case, the prior art that was not made of record in the Patent Office was similar to that which was made of record and, therefore, was merely cumulative. It is only where more pertinent prior art that was not considered by the Patent Office is brought forth in the Court that the presumption of validity is weakened. To hold that merely citing cumulative prior art, no more pertinent, would weaken the presumption of validity would

emasculate the provisions of the Statute. We submit that this Court should exercise its powers of review here to eliminate this erroneous concept of the Court of Appeals of the Eighth Circuit.

The Patent in Suit
Meets the Test of Invention.

Was the device shown in the Graham patent No. 2,627,798 a solution to a problem? Was it useful? Was it new? There had been a problem of breakage of plows in the rocky territory and, while there might be different solutions for the problem, certainly the subject Graham patent was one solution. It was useful because it permitted plowing in such rocky country. Furthermore, devices which came under the patent were admittedly commercial successes. Was it new? It did have some old elements, but that does not defeat invention. The Graham patent structure was new. In all of the prior art wherein a chisel shank was mounted for pivotal movement, there was not one that had the arrangement, operation and action of the Graham structure. The Court of Appeals does not point out wherein any of the prior art would teach modifications of other prior art to form a structure such as in the Graham patent. It merely stated that it thought the difference between the prior art and the Graham patented structure was not sufficient to support the patent. The Court, in its opinion, mentions the arrangement for obtaining the flexibility in the shank and the difference in the bending thereof from that shown in the prior art, but then it states that that function or result is not found in the claims or in the specification. There was no holding that the specification was insufficient to teach someone how to build the structure. It is submitted that when the drawings and specification of a patent teach how the structure is to be made, the patent

has complied with the statute as to disclosure. There is no requirement in the statute that there be any detail or description as to every function or result that will or can be obtained. To suggest that the absence of details of function or result in a specification or claims of a patent is a proper ground for holding the patent invalid is clearly a basis that is not in accordance with the statute, and that is completely contrary to the law.

In the past, many claims have been held improper because they were functional or claimed the result instead of the structure (*Halliburton Oil Well Cementing Co.* v. *Walker* (1946), 329 U. S. 1; *Refrigeration Patents Corp.* v. *Stewart-Warner Corp.* (1947), 7 Cir., 159 F. 2d 972; *Parker Appliance Co.* v. *Irvin W. Masters, Inc., et al.* (1950), 94 F. Supp. 72, aff. 9 Cir., 193 F. 2d 180). In the present case, the patentee has described the structure and claimed the structure, and the Court of Appeals for the Eighth Circuit holds the patent invalid because it did not do exactly what has been condemned through the years.

The defendant, Deere & Company, was in serious difficulties because they had nothing to solve the problem of plowing in the rocky territory. They made surveys and thereby knew the plaintiff's patent showed a practical solution. With all of the engineers of this huge company, they did not follow the prior art to find a solution; in fact, they did not find a solution, they merely copied plaintiff's patent structure.

There was no finding by the Court of Appeals that any prior art device was like that of the patent. There was no finding that any of the prior art had the same action. There was no finding that the patent structure would not produce a better result or the same result in a more economical, facile manner. There was only the finding of the Court of Appeals that there was an improper test used

by the District Court, namely, that the District Court did not find any new result. Also, there was an independent search on which the Court of Appeals embarked to find some excuse to hold the patent invalid. It disregards the requirements of the statute that a patent *disclose the structure.* It disregarded the requirement that the claims *specify the structure.* It held that the failure of the specification and claims to spell out function and result was a fatal defect and, therefore, the patent was invalid. It is submitted that this is going to the ultimate of extremes to find an excuse to hold a patent invalid.

The Court of Appeals went further, disregarding Rule 52 of the Federal Rules of Civil Procedure and the District Court's findings regarding the fact that none of the prior art structures were like the patent structure. They held the flexing provided by the patent structure was insignificant. It made this holding in the face of the fact that the defendants clearly made their structure to have such flexing. It had to be significant; otherwise, Deere & Company's engineers would have made the structure with the shank above the plate so that it would be like the prior art. We submit that the Court of Appeals has erred in its opinion and it should be reversed and the District Court's judgment reinstated.

Conclusion.

In conclusion, it is submitted that it is important that all litigants may have their questions of patent validity determined according to uniform decisions of this Court. It is important that the patent statutes be interpreted properly and that patentability be determined in accordance with the statutes and not by some test or standard having requirements that are outside of the statute or that have

been eliminated by the statute. To preserve the security under the law regarding patents that should be afforded by the decisions of this Court, is of vast importance to the entire public, but particularly to all manufacturers of, dealers in, and users of machines, devices and commodities which are or may be covered by patents.

It is, therefore, respectfully submitted that this case is one calling for the exercise by this Court of its supervisory powers in order that conflict of decisions of a Federal question by the United States Court of Appeals for the Eighth Circuit and that of the Fifth Circuit may be removed, in order that important questions of Federal Law decided by the United States Court of Appeals for the Eighth Circuit which have not been but should be settled by this Court may be settled by this Court, and to such an end a writ of certiorari should be granted, and this Court should review the decision of the United States Court of Appeals for the Eighth Circuit and finally reverse said decision.

Respectfully submitted,
CLAUDE A. FISHBURN,
ORVILLE O. GOLD,
Counsel for Petitioners.

October 8, 1964.

APPENDIX A

United States Court of Appeals

FOR THE EIGHTH CIRCUIT

No. 17,441

John Deere Company of Kansas City, a Corporation, and Deere & Company, a Corporation, Appellants, v. William T. Graham, and Graham Plow, Inc., Appellees.	Appeal from the United States District Court for the Western District of Missouri.

[June 18, 1964.]

Before VOGEL, MATTHES and BLACKMUN, Circuit Judges.

MATTHES, Circuit Judge.

This is an action for infringement of Patent No. 2,627,798 (hereinafter sometimes referred to as "Patent No. 798") issued to William T. Graham (plaintiff-appellee) on February 10, 1953, for a "Clamp for Vibrating Shank Plows." Graham Plow, Inc. (plaintiff-appellee) is

a licensee under the patent. The trial court found the patent valid and that Claims 1 and 2 of the patent were infringed by defendants John Deere Company of Kansas City and Deere & Company. From the judgment entered pursuant to findings of fact and conclusions of law defendants (hereinafter called "appellants") have appealed. Jurisdiction is established by virtue of 35 U.S.C. § 281 and 28 U.S.C. § 1338.

Appellants advance two basic contentions. (1) That Patent No. 798 is invalid for want of invention and that the findings for appellees on this issue is clearly erroneous because the trial court: (a) failed to give proper consideration and effect to the rule that the presumption of validity is weakened when pertinent prior art was not considered by the Patent Office; (b) applied an improper test of invention. (2) That even if validity of the patent is sustained, appellants' accused devices do not, within the rule or doctrine of equivalents, infringe Patent No. 798.[1] If appellants' position as to contention (1) is sound, i.e., if the Graham patent is invalid for want of invention, there can be no infringement of its claims and we need not consider contention (2). *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co. (Inc.),* 8 Cir., 277 F. 2d 884, 886 (1960); *Caldwell* v. *Kirk Manufacturing Company,* 8 Cir., 269 F. 2d 506, 507 (1959), cert. denied, 361 U. S. 915 (1959); *Briggs & Stratton Corporation* v. *Clinton Machine Co.,* 8 Cir., 247 F. 2d 397, 400, 401 (1957), cert. denied, 355 U. S. 914 (1958).

Appellees urge and rely upon the uncontroverted rule, established by statute and consistently recognized by the

[1]For a comprehensive and enlightening discussion of the doctrine of equivalents, see *Parmelee Pharmaceutical Company* v. *Zink,* 8 Cir., 285 F. 2d 465, 470, *et seq.* (1961).

courts, that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on the party asserting it. 35 U.S.C. § 282; e.g., *Radio Corporation of America* v. *Radio Engineering Laboratories, Inc.*, 293 U. S. 1, 7-8 (1934); *Steffan* v. *Weber Heating and Sheet Metal Company*, 8 Cir., 237 F. 2d 601, 602 (1956). It is equally clear, however, that the presumption of validity is a rebuttable one, that when substantial evidence attacking the validity of a patent is introduced, the question whether the patent constitutes an invention is for the court, *Steffan* v. *Weber Heating and Sheet Metal Company, supra*, 237 F. 2d at 602; *Continental Farm Equipment Co.* v. *Love Tractor*, 8 Cir., 199 F. 2d 202, 204 (1952), cert. denied, 345 U. S. 909 (1953), and that the presumption of validity is weakened if applicable prior art is not considered by the Patent Office. *L. S. Donaldson Company* v. *La Maur, Inc.*, 8 Cir., 299 F. 2d 412, 420 (1962), cert. denied, 371 U. S. 815 (1962); *Day-Bright Lighting, Inc.* v. *Sandee Manufacturing Co.*, 7 Cir., 286 F. 2d 596, 597 (1960), cert. denied, 366 U. S. 963 (1961); *Cornell* v. *Adams Engineering Company*, 5 Cir., 258 F. 2d 874, 875 (1958).

If, as urged by appellants, the trial court failed to apply the proper legal test or standard, it necessarily follows that its finding of patentabiltiy was induced by an erroneous view of the law, its finding is clearly erroneous, and the judgement based upon such finding cannot stand. *Great A. & P. Tea Co.* v. *Supermarket Equipment Corporation*, 340 U. S. 147, 153-154 (1950); *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co. (Inc.), supra*, 277 F. 2d at 886; *Caldwell* v. *Kirk Manufacturing Company, supra*, 269 F. 2d at 508, 509.

This court has adhered to the position that since *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S.

84 (1941), "the amount of originality and ingenuity, over and beyond novelty and utility, which will constitute invention necessary to sustain a patent for a combination of old elements [such as we have here] in a crowded art, has increased." *Briggs & Stratton Corporation* v. *Clinton Machine Co., supra,* (concurring opinion of Judge Sanborn, 247 F. 2d at 401) and cases there cited. In *Caldwell* v. *Kirk Manufacturing Company, supra,* 269 F. 2d at 509, Judge Sanborn again expressed the principle in this language:

> "More exacting standards for determining patentable invention have been applied by the courts in recent years than was formerly the case. In *Trico Products Corporation* v. *Delmar Corporation,* 8 Cir., 180 F. 2d 529, 533, this Court said:
>
> "'* * * 'The Supreme Court has, we think, raised the standards of originality necessary to sustain patents for improvements such as those involved in the instant cases, regardless of their usefulness or commercial success. Compare, *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523, and *Temco Electric Motor Company* v. *Apco Manufacturing Company,* 275 U. S. 319, 48 S. Ct. 170, 72 L. Ed. 298, with *Cuno Engineering Corp.* v. *Automatic Devices Corp., supra,* 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58.' "

The same pronouncement appears in *Steffan* v. *Weber Heating and Sheet Metal Company, supra,* 237 F. 2d at 604; *Selmix Dispensers, Inc.* v. *Multiplex Faucet Co.* (Inc.), *supra,* 277 F. 2d at 887; and *Crome & Company* v. *The Vendo Company,* 8 Cir., 299 F. 2d 852 (1962), where Judge Blackmun in his dissent observed, "Mechanical combination patents in this court have met with little recent success."

Appendix A

With these pronouncements clearly in mind, we turn to the factual setting of the case. Inasmuch as the trial court's Memorandum Opinion, Findings of Fact, and Conclusions of Law, W.D. Mo., 216 F. Supp. 272 (1963), adequately embody the general factual background, including the terms of the patent claims and other technical descriptions, we need here set forth only a condensed version of the facts.

Appellee Graham originally submitted twelve claims in his application to the Patent Office for a patent on a device which eventually was issued as Patent No. 798. The Patent Office rejected all twelve claims, partially on the grounds that some of them failed to patently distinguish from a prior patent issued to Graham—No. 2,493,811 (Patent No. 811)—and partially on the grounds of lack of invention. Graham then submitted two claims to be substituted for the original twelve, and these two claims were the basis for issuance of the 798 Patent.

Broadly stated, Patent 798 relates to the mounting of tools on a frame which is moved over the ground to break the soil—a process termed "chisel plowing." Appellee Graham Plow, Inc.'s predecessor manufactured and sold chisel plows wherein the upper forward portion of the shank was rigidly fixed to the plow beam by a *rigid* clamp. Because these rigid structures proved to be unsatisfactory due to their inability to withstand shocks when used for plowing in rocky country, Graham devised a *spring* clamp structure, and was issued a patent—No. 811—on it in January, 1950. Graham Plow, Inc. has continued to manufacture and sell plows with spring clamps which embody the principle of the 811 Patent, but neither appellees, nor any licensee under them, has ever manufactured or sold a clamp embodying the 798 structure.

Appendix A

The 798 clamp—also a "spring clamp"—is used to connect the upper forward end of a resilient shank to a beam with the lower end of the shank carrying a chisel for plowing or other ground-working operations. The clamp includes a body portion movably attached to the beam with a rearward portion having a pivot pin on which is pivotally mounted a movable part with a plate portion extending forwardly or longitudinally of the normal direction of travel of the plow. The upper forward portion of the shank extends through a stirrup or loop element at the rear of the movable part and longitudinally *beneath* the plate portion of the movable part and is connected to the plate at the forward end thereof at a substantial distance from the pivot pin, whereby the shank and movable part pivot together about the axis of the pivot pin. A coil spring is arranged at the forward end of the body and, through a nut, washer and spring rod, acts on the shank and plate member to resiliently urge the forward end of clamp to a stop engagement therewith to normally hold the shank in normal position. In plowing operations forces are exerted rearwardly and upwardly on the chisel or other ground-working tool, and when sufficient to overcome the forces applied by the spring the shank and movable part will pivot on the pivot pin with the forward end of the shank and plate moving downwardly against the tension of the spring. Forces in plowing hold the shank against the rear of the plate of the movable part and when said forces are removed or lessened, or the ground-working tool removed from the ground, the shank at the rear of the movable part is supported by a stirrup or loop that embraces the shank adjacent the pivot of the movable part. In plowing operations, if the ground-working tool

strikes a rock or other obstruction, substantial shock and forces are applied to the shank, pivoting the shank and movable member about the pivot pin, tending to compress the spring and permitting upward movement of the ground-working tool whereby it can pass over the rock or obstruction and, as it passes over such obstruction, the stirrup or loop on the movable part supports the shank against excessive rebound.

Five prior patents indicating the state of the prior art were made of record in the Patent Office during Graham's prosecution of the application for the 798 Patent. Four of these patents, ten others not of record in the Patent Office, and two other prior spring clamp devices not of record in the 798 file wrapper, were relied upon below by appellants as revealing the prior art.

Since our disposition of this case, as subsequently revealed, does not necessitate resolution of the infringement issue, we forego discussion of appellants' two accused devices, found to infringe Patent 798.

The following summarized finding of the trial court on the validity issue, among other findings and conclusions, induced the ultimate decision in favor of appellees:

(1) Although not all the now disclosed prior art was cited by the Patent Office, the statutory presumption of validity of the 798 Patent is not weakened or destroyed since the uncited prior art is "similar to some of the patents relied upon by the Patent Office Examiner."

(2) The prior art as a whole in one form or another contains all of the mechanical elements of the 798 Patent, and in a broad sense all of the elements are found in the Glencoe clamp. [Glencoe was not cited by the Patent Office]. Nevertheless, the particular arrangement of the

elements disclosed by 798 is not present in any single reference or as a whole.

(3) An *improved* functional result is obtained by the 798 Patent, and the main improvement is due to the particular arrangement of the shank in relation to the pivoted member and spring member which reflects in downward flexing of the shank at the forward portion thereof alongside the plate portion of the pivoted member and does lessen wear and tear to some parts of the clamp.

(4) The 798 Patent is an improvement patent and, while the individual mechanical elements may be found in the prior art, taken as a whole the 798 structure is sufficiently different in the operative relationship of the shank and pivoted member with a slight but significant difference in the flexing of the forward portion of the shank that is not found in the prior art, so that the 798 structure involves invention.

(5) The differences between the 798 Patent and the prior art are such that the 798 combination would not have been obvious at the time Graham made his invention to a person having ordinary skill in the art of agricultural implements and other related arts.

We approach determination of the validity issue fully cognizant that the mere fact that all of the elements embodied in the 798 structure are found in the prior art does not ipso facto mean that the combined structure is not patentable. *Continental Farm Equipment Co.* v. *Love Tractor, supra,* 199 F. 2d at 205. However, we also announced in *Continental, supra,* 199 F. 2d at 205, citing *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp., supra,* 340 U. S. at 152, that when combination patent claims are under examination, courts should scrutinize them with a care proportioned to the difficulty and improbability

of finding invention in an assembly of old elements. To be patentable, a combination of individually old elements must contribute something new; the elements must cooperate to produce an accumulation which exceeds the sum of its parts. E.g., *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp., supra,* 340 U. S. at 151-152; *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U. S. 545, 549 (1938); *John Blue Company* v. *Dempster Mill Mfg. Co.,* 8 Cir., 275 F. 2d 668, 672-673 (1960); *Caldwell* v. *Kirk Manufacturing Company, supra,* 269 F. 2d at 508. Compare also, *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.,* 7 Cir., 230 F. 2d 409, 415-416 (1956). Stated differently, "The bringing together of old elements in a mechanism involving no new principle, to produce an old result, however skillfully done, even though the result marks an advance in efficiency and utility, is but an exercise of mechanical skill and not invention." *General Bronze Corp.* v. *Cupples Products Corp.,* 8 Cir., 189 F. 2d 154, 161 (1951).

Our task is to first ascertain whether the trial court applied the proper legal standard in determining the validity of Patent 798, and then to decide whether the patent satisfies the requirements of this test. At this point, we note that the 798 Patent has been held valid on two occasions in appeals before the Fifth Circuit. *Jeoffroy Mfg., Inc.* v. *Graham,* 219 F. 2d 511 (1955), cert. denied, 350 U. S. 826 (1955), and *Graham* v. *Cockshutt Farm Equipment, Inc.,* 256 F. 2d 358 (1958). Unlike our court, the Fifth Circuit has "long recognized . . . that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where . . . it produces an *old result in a cheaper and otherwise more advantageous way.*" (Emphasis supplied). 219 F. 2d at 519. For other recognition by the Fifth Circuit of the "old result in a

more efficient and economical way'' see, *Cornell* v. *Adams Engineering Company, supra,* 258 F. 2d at 875-876.

Undoubtedly, and perhaps understandably, the trial court below was at least partially motivated in its decision by the two prior Fifth Circuit cases involving Patent 798. Of course, the decisions of another circuit are entitled to respect and are not to be brushed aside lightly, but they are not binding upon appellants in this case, nor upon us. See *Aeration Processes* v. *Lange,* 8 Cir., 196 F. 2d 981, 982 (1952), cert. denied, 344 U. S. 834 (1952). It is for this court, upon the record here, including the arguments, stipulations, and concessions, to decide whether Patent 798 is valid.

Here, the trial court couched its Finding XV rather precisely in the statutory standard of invention found in 35 U.S.C. §103, and found that the 798 Patent structure would not have been obvious at the time it was made to a person having ordinary skill in the art. But, other findings of the court lay stress on "an *improved* functional result," and nowhere does the court find any new or significantly different result. Seemingly, the trial court failed to apply the more exacting standard which in our view is implicit in the teachings of the Supreme Court in *Cuno Engineering Corporation, supra,* 314 U. S. 84, and *Great A. & P. Tea Co., supra,* 340 U.S. 147, and which we have applied in numerous cases subsequent thereto.

Furthermore, even assuming that the trial court's finding of "a slight but significant difference in the flexing of the forward portion of the shank that is not found in the prior art'' can be construed as a finding of a new result, the court's further finding that Patent 798 exhibits invention and would not have been obvious to a person having ordinary skill in the art is clearly erroneous. The alleged

patentable difference between the 798 structure and the prior art lies in the arrangement of the 798 structure of the shank *below* the plate of the pivoted member, permitting the shank to flex throughout its length and particularly permitting the forward portion of the shank to flex downwardly *away* from the plate. Theoretically, at least, when the plate is below the shank, as in the prior art, there is a tendency of the shank to bend *against* the plate and when the plate is above, as in the 798 Patent, there is a tendency of the shank to bend *away from* the plate.

But is this difference significant enough to support the patent? We think not. Painstaking examination of the entire record, including the testimony of the experts, convinces us that the changes in the prior art embodied in the 798 Patent involve only application of mechanical ability, and that there is no adequate evidentiary support for the trial court's finding of invention. As surely as the disc harrow device in *Continental Farm Equipment Co.* v. *Love Tractor, supra,* 199 F. 2d 202, and the animal rubbing and oiling apparatus in *Caldwell* v. *Kirk Manufacturing Company, supra,* 269 F. 2d 506—to name but two, did not involve inventive genius, neither does the rearrangement of shank, plate and pivot pin in the 798 structure. While perhaps more efficient, the inversion of the parts so as to allow the shank to flex downwardly away from the plate above it did not bring about a significantly new or different result, and would have been obvious to a person having ordinary skill in the art.

Additionally, it is significant that in the 798 Patent claims, nothing is mentioned about the shank flex which became the basic reason for sustaining the validity of the patent in the trial court. To be sure, it is the claim that measures the grant to the patentee, *Briggs & Stratton Cor-*

poration v. *Clinton Machine Co., supra,* 247 F. 2d at 400, and here the claims of the 798 Patent are silent concerning the alleged flex.[2] Appellants point out that, to the contrary, any flexing of the shank away from the plate portion of the pivoted member would be in direct conflict with the claims which specify that the means connecting the shank to the plate maintain "the upper face of the shank in *constant continuous* contact with the underface of said plate portion of the shank attaching member." (Emphasis supplied).[3] See entire claims set forth, *supra,* 216 F. Supp. at 274-275.

It is also interesting to note that in the early stages of this case appellees propounded three interrogatories under Rule 33, Fed R. Civ. P., inquiring as to flex in the shank of appellants' accused devices. Appellants objected

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[2]In *Lincoln Engineering Co.* v. *Stewart-Warner Corp., supra,* 303 U. S. at 550, the Supreme Court, in refusing to accept a suggestion that a function, not mentioned in the specifications of the patent, was significantly new and different so as to support the validity of the patent, stated:

> "The suggesion seems to be an afterthought. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted."

[3]Appellees take issue with this assertion, stating that appellants "are interpreting the wording of the claims to specify that the contact between the upper face of the shank and the under face of the plate portion is for the entire length of those faces, but the claims do not say that. *There is no extent of such contact specified in the claims.* Actually in the structure the bolt and nut at the forward end of the plate and shank maintain the upper face of the shank in constant continuous contact with the under face of the plate portion of the shank-attaching member at that part where the bolt and nut pass through. . . . The flexing is in that portion of the shank that is rearwardly of that bolt. . . ." (Emphasis supplied.)

on the grounds that the interrogatories were not relevant, and Judge Ridge—then sitting on the case—sustained the objections, stating:

> "These interrogatories relate to a flexing of the shank of the accused device, and appear irrelevant since such a flexing is not a claim of the patent in suit and Plaintiffs do not undertake to otherwise demonstrate the relevancy of such inquiry."

In conclusion, we observe once again that the Constitution, Article I, Section 8, Clause 8, authorizes Congress to reward inventive genius but not mechanical skill alone. *Cuno Engineering Corporation* v. *Automatic Devices Corporation, supra,* 314 U. S. at 91; *Steffan* v. *Weber Heating and Sheet Metal Company, supra,* 237 F. 2d at 604. The public is a silent but an important and interested party in all patent litigation, and is entitled to protection against the monopolization of what is not lawfully patentable. *Rota-Carb Corporation* v. *Frye Manufacturing Company,* 8 Cir., 313 F. 2d 443, 444 (1963). For a recent discussion of the purpose of federal patent law and the need to guard the rights of the public, see *Sears, Roebuck & Co.* v. *Stiffel Co.,* 376 U. S. 225, 228-231 (1964).

Since we have concluded that the 798 Patent is invalid, there is obviously no need to consider the infringement issue.

Accordingly, and for the reasons stated in the opinion, the judgment is reversed and the case remanded with directions to dismiss the action.

A true copy.

Attest:

Clerk, U. S. Court of Appeals, Eighth Circuit.

APPENDIX B

JUDGMENT.

United States Court of Appeals

FOR THE EIGHTH CIRCUIT.

No. 17,441.

John Deere Company of Kansas City, a Corporation, and Deere & Company, a Corporation, Appellants, v. William T. Graham, and Graham Plow, Inc.	Appeal from the United States District Court for the Western District of Missouri.

This cause came on to be heard on the record from the United States District Court for the Western District of Missouri, and was argued by counsel.

On Consideration Whereof, It is now here Ordered and Adjudged by this Court that the judgment of the said District Court in this cause be, and the same is hereby, reversed with costs; and that John Deere Company of Kansas City, a Corporation, and Deere & Company a corporation, have and recover against William T. Graham, and Graham Plow, Inc., the sum of Four Thousand Two Hundred Twenty-two and 32/100 Dollars for their costs in this behalf expended and have execution therefor.

And it is further Ordered by this Court that this cause be, and it is hereby, remanded to the said District Court with directions to dismiss the action.

June 18, 1964.

APPENDIX C

United States Court of Appeals

FOR THE EIGHTH CIRCUIT.

September Term, 1963.

No. 17,441

John Deere Company of Kansas City, a corporation, and Deere & Company, a corporation, Appellants, v. William T. Graham and Graham Plow, Inc.	Appeal from the United States District Court for the Western District of Missouri.

Petition of appellees for rehearing filed in this cause having been considered, it is now here ordered by this Court that the same be, and it is hereby, denied.

July 13, 1964.

APPENDIX D

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 15117

JEOFFROY MFG., INC.,
Appellant,

versus

WILLIAM T. GRAHAM,
Appellee.

AND

WILLIAM T. GRAHAM,
Appellant,

versus

JEOFFROY MFG., INC.,
Appellee.

Appeals from the United States District Court for the Northern District of Texas.

(February 11, 1955.)

Before HUTCHESON, Chief Judge, RIVES, Circuit Judge, and DAWKINS, District Judge.

Appendix D

RIVES, Circuit Judge: This suit was filed by Jeoffroy Mfg. Inc. on May 15, 1952, for declaratory judgment to determine whether a spring trip device used on its commercially manufactured plow infringes United States Patent No. 2,493,811, issued on January 10, 1950 as "Vibrating Plow and Mounting Therefor," and owned by William T. Graham.[1]

By counterclaim, Graham charged Jeoffroy with infringement of its aforementioned patent, No. 2,493,811, and also with infringement of its United States Patent No. 2,627,798, issued February 10, 1953, and entitled "Clamp for Vibrating Shank Plows."

On a prior appeal involving the same parties and Graham's No. 2,493,811 patent, this Court affirmed with immaterial modification the judgment of the district court holding that patent valid and infringed by a device formerly manufactured and sold by Jeoffroy. See *Jeoffroy Mfg., Inc.* v. *Graham,* 206 F. 2d 772, cert. den. 347 U. S. 920.

The district court held patent No. 2,493,811 valid and infringed, and further held patent No. 2,627,798 invalid for lack of invention.[2] Jeoffroy has appealed only from

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[1]Both the corporate appellant, Jeoffroy Mfg., and the individual appellee, William T. Graham, are located at Amarillo, Texas, where they are competitively engaged in the manufacture and sale of commercial plows. To avoid confusion in referring to the parties in the two consolidated appeals, they will hereinafter be called Jeoffroy and Graham respectively.

[2]The district court's opinion is succinctly set forth in two letters to counsel for the respective parties, which were filed of record but are not officially reported. The most pertinent portions of those letters read as follows:

"Patent No. 2,493,811

"The Graham Patent 811 may rank as a pioneer patent within the sense of some strong cases, including a number

that portion of the judgment holding the former Graham Patent infringed, while Graham has appealed from the holding as to invalidity of his later improvement patent for lack of invention. In view of this Court's decision on

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of combination patents, but I lean to the opinion that it is ruled rather by the teaching of other leading cases, and embodies a meritorious, yet not an outright pioneer, invention. Even if it is only a meritorious invention, being of proven worth, the patentee is entitled to claim a substantial range of equivalents, consistently with the context of the patent, the Patent Office history and the prior art and use. * * *

"The said Graham patent has already been adjudged valid by this Court in an earlier case, and in that previous trial the prior art was examined in reference to the validity of the patent. The inquiry is not being retraced from that standpoint at the present time, but has been noticed as it bears on the scope of claims and proper range of equivalents under the said patent. * * *

"Next in order is the question of infringement. The Graham patent, claim 5, in the element of a shank between the fixed member and the movable member of the bracket and in movable engagement with the said parts will not read on the accused Joeffroy device. The argument on the point of position that the stirrup and the yoke in the Jeoffroy structure suffice to put the shank between a part of the movable member and the fixed member of the Graham construction is too far fetched. * * * Likewise the correlated claim language 'in movable engagement with the said parts' probably will not read on the accused Jeoffroy structure. * * *

"The fact that the Graham patent, claim 5, cannot be read literally on the accused device is not at all conclusive against infringement. The doctrine of equivalents must be reckoned with, and most often comes into play with apparatus or mechanical inventions. * * * True in the accused device the shank is placed below the movable member of the bracket, unlike the patent arrangement above said movable member, but that is simply a reversal of position, and the Courts speak with one voice in saying that mere transportation of members in a combination structure, where there is no actual change of function, is just an equivalent and fails to avoid infringement. * * *

"The accused structure has simply supplanted the dual function of the spring bolt in the patented structure by the

the prior appeal, no issue is presented as to the validity of patent No. 2,493,811, the basic question confronting us for determination being whether that patent is infringed by the accused device now manufactured and

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expedient of a new element, and with that change cessation of longitudinal motion of the shank follows. The mere elimination of virtually all of that particular motion, which was not indispensable anyway to the principle of the invention claimed in the Graham patent, results incidentally from an example of using two elements to do what was done before by a double duty element and such an alteration will not avoid infringement of the patent. * * *

"* * * my conclusion (is) that the Graham patent, as aided by the doctrine of equivalents, is infringed in claims 5 and 6 by the Jeoffroy structure.

"Patent No. 2,627,798

"The recent Graham structure covered in the above numbered patent, issued in 1953, is a plain counterpart of the accused structure made by Jeoffroy. The same reasons for finding infringement against Jeoffroy, also disclose invalidity of this latest Graham patent. It is a case of double patenting between the two Graham patents, and so under the ban of a well settled rule of patent law. If the said patent were not invalid as a double patent, in any event it would be for lack of invention. This patent 798 does mark an improvement bettering efficiency and economy over patent 811, but that is not enough to constitute invention. The said patent 811 was the springboard and from that vantage background the next step from that structure to the structure of patent 798, was well within the capacity of a skilled mechanic.

"Counsel will submit a decree on the cross action as to the infringement of patent 811, and adjudging patent 798 invalid * * * "

The above quotations are from the Court's letter opinion, dated September 9, 1963, announcing its original decision In overruling Jeoffroy's motion for rehearing, it further amplified its prior letter opinion as follows:

"Plaintiff's counsel * * * insist that the shank in the latest Jeoffroy bracket, by being bolted towards the front end of the movable fulcrum plate, is, in effect, hinged directly to the plow frame. Thus it is likened to the operation of the prior art in contrast to that of Patent No. 811. It is difficult for me to see how such claim is much better for

sold by Jeoffroy. However, Jeoffroy does defensively assert the alleged invalidity of Graham's improvement patent No. 2,627,798, both as anticipated in fact by the prior art and invalid in law for lack of invention, though it frankly concedes infringement of that patent by its new structure if the patent is valid.

I. Issue of infringement of Patent No. 2,493,811.

We think the basic structure, mode of operation and purpose of Patent No. 2,493,811, hereinafter simply referred to as the Graham 811 patent, is adequately set forth in our former decision and need not be restated

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this last Jeoffroy type than in the earlier litigation. Of course, the nib and socket pattern in that earlier type did not hold the shank and the fulcrum plate together so rigidly as can be done by the nut and bolt in the present type, but I think the difference inconsequential from the standpoint of the present inquiry. In my opinion, consistency is lost in any theory that the prior art was insufficient to shelter the earlier Jeoffroy type, but is sufficient to shelter the latest Jeoffroy type. * * *

"* * * The argument in support of the motion before the Court stresses the contention that the modes of operation are entirely different in the Graham structure and the Jeoffroy structure. The gist of it is that the Graham structure features a shank nested between a movable and a fixed member of the bracket and without any rigid attachment, while the Jeoffroy structure uses a shank tightly bolted to the movable member of the bracket, like its alleged prototypes in the mechanical art and that by such assembly it is, in effect, hinged directly on a fixed member of the bracket or plow frame. I am unable to agree with that position. In my opinion, the shank mounted in the way stated retains tangibly more useful motion and vibration than would be true if it were actually attached rigidly to a fixed member. * * *

"* * * the only essentials, as I see, are a finding of infringement of Patent No. 811 and invalidity of Patent No. 798, together with the conclusion that defendant is entitled to injunctive relief, but reserving the question of damages for future determination. * * *"

here. *Jeoffroy Mfg.* v. *Graham, supra,* at pp. 773-774. Only claims 5 and 6 of this patent are here involved.[3] Our inquiry on this infringement issue is further narrowed to a consideration of the specific language of claim 5, in view of Jeoffroy's admission that, while the bracket of its accused device exhibits some divergence in structure from the channel shaped formation of claim 6, it must nevertheless be conceded "that if we infringe Claim 5 we likewise infringe Claim 6."

We think the district court properly held that claim 5 could not be read in express terms upon the new Jeoffroy structure, since the Jeoffroy shank is not "be-

[3]These two claims in issue of Graham's 811 patent read as follows:

"5. In a plow having a frame and a ground working tool provided with a shank adapted to rock relatively to the frame when the plow is in operation in a forward direction, a mounting for attaching and supporting the shank of the ground working tool from the frame including a clamp fixedly attached to the frame, the clamp including a part that is fixed to the frame and another part pivotally mounted on the fixed part, the shank having an end portion thereof between said parts and in movable engagement with the said parts, a coil spring having one end thereof in engagement with one of said parts, means at the other end of the spring connected with the other of said parts to maintain the spring in position and for holding the said parts of the clamp with the end portion of the shank therebetween in their resiliently held-together association so that when the shank is rocked or moved the end portion of the shank between the parts will cause the movable part of the clamp to move away from the fixed part along with said end portion and back to normal position with the end portion of the shank contactingly held between the two parts, and means on one of the parts engageable with a part of the end portion of the shank to prevent disengagement of the shank from the clamp but to allow same to rock.

"6. In a device as claimed in and by claim 5, wherein the fixed part of the clamp is of channel shape formation and the said end portion of the shank is disposed therein and prevented from moving laterally."

tween the fixed member and the moveable member of the bracket and in moveable engagement with the said parts." (See footnote 2, *supra.*) Like the district court, we reject as "too far fetched" Graham's insistence that the position of the Jeoffroy stirrup and yoke below the shank sufficiently locates the shank between at least a part of the moveable member and fixed member so as to satisfy the literal language of the claim. Graham's insistence in this respect, like his further contention that the Jeoffroy structure meets the call of claim 5 for a shank "in moveable engagement with the said parts" because of the looseness in the bolt fitting which connects the yoke, shank, and hinge and the small amount of play at the forward end of the shank between the stirrup and yoke, seems to us to stretch the express wording of claim 5 beyond the fair intendment of the language used in order to cover a substantially divergent structure. Irrespective, however, of our adoption of the district court's conclusion that no infringement exists in express terms, there nevertheless remains for our consideration the question of whether the trial court justifiably held claims 5 and 6 of Graham's 811 patent infringed under a broad application of the doctrine of equivalents.

We agree with the district court's statement that Graham's 811 patent "embodies a meritorious, yet not an outright pioneer invention," and that it is entitled to a range of equivalents consistent "with the context of the patent, the Patent Office history and the prior art and use." (Footnote 2, *supra.*) For reasons hereinafter stated however, we disagree with its conclusion that the doctrine of equivalents should be broadly applied in this instance so as to bring the new Jeoffroy structure within the condemnation of Claims 5 and 6.

Appendix D

If the litigation involving this patent were of first impression, we might appropriately concede that Graham's protection thereunder ought not be confined to this type structure disclosed by the patent claims and specifications. Under such circumstances, the trial court's finding of a mere transposition of members in the accused structure, with "no actual change of function," might be sufficient to warrant its finding of equivalence. *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, 609. However, we think the prior course of this litigation, in the Patent Office and in this Court, justly requires such limitation of the scope of the Graham 811 claims in issue as would necessarily prevent Graham from successfully urging infringement by the new Jeoffroy device.

In the former suit involving the old infringing Jeoffroy structure (*Jeoffray Mfg., Inc.* v. *Graham, supra*), in order to distinguish the inventive concept embodied in his 811 patent from the prior art, Graham repeatedly and successfully urged upon the district court and this Court that his patent was not anticipated by a structure in which the shank is either directly pivoted on a fixed member,[4] or is attached to a hinge member that is directly

[4]For example, in his brief on the former appeal, Graham made the following argument as to validity of his 811 patent, the substance of which was adopted by this Court in its opinion:

"Prior art patents relied on by Defendants have not contributed anything to this art and particularly the art of resiliently and frictionally holding the shank of a ground working tool between a fixed part and a movable part, i.e., the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. Graham was the first to produce a device which successfully provided for mounting of a ground working tool shank that would rock and yet not have the shank hinged directly on a fixed member, this new structure providing an action of the ground working tool never before accomplished, and in entirely different distribution of forces which was not possible in prior devices."

pivoted on the fixed member, yet he now contends that the new Jeoffroy structure, which we think embodies substantially the type attachment there distinguished by him, infringes this same patent. Moreover, Graham also testified in both the former and present suits that longitudinal motion of the shank relative to the hinge member was at least an important part of his invention,[5] yet he now urges that the absence of such motion in Jeoffroy's new structure is practically immaterial and insufficient to avoid infringement.[6] Furthermore, in filing application for his improvement patent, No. 2,627,798, with the Patent Office, which patent, if valid, both parties agree is infringed by the practically identical new Jeoffroy device, Graham contended that his shank was "rigidly secured" to the hinge member,[7] yet he now asserts in order to sustain his present charge of infringement that the new Jeoffroy device, its structural twin and counter-

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[5]Graham's testimony in the present suit on this issue reads as follows:

"Q. Do you consider longitudinal movement between the fulcrum member and the shank—or to put it another way—longitudinal movement of the shank relative to the fulcrum member in your patented structure as shown in your old patent 2,493,811 to be an important feature of that patent?

"A. Yes, I think it's rather important.

"Q. Do you consider that as a part of the invention, the alleged invention, Mr. Graham?

"A. Yes, I think so."

[6]See Paragraph 5 of trial court's findings, footnote (2), supra.

[7]The file wrapper of Graham's new patent, No. 2,627,798, reveals that Graham there represented one of the objects of his alleged invention was "to provide a mounting which includes a fixed part and a movable part pivotally connected with the fixed part and having a shank attaching portion to which the shank is *rigidly secured* and resiliently retained on the fixed part." (Emphasis supplied.)

part, is "in moveable engagement" with the hinge member. Similarly, in prosecuting his new 2,627,798 patent application before the Patent Office he successfully urged, in effect, that patentable novelty and invention existed therein over his old 811 patent because, among other features, his different method of attaching the shank in his improvement patent, i.e. its location beneath the hinge member and rigid attachment thereto, resulted in a different mode of operation and distribution of stresses from that which had precipitated an inordinate amount of wear in the old sliding pivot and fulcrum assembly of his 811 patent,[8] yet he now contends that the new Jeoffroy structure, which concededly duplicates the structure of his new patent, nevertheless retains that same degree of flexibility and method of operation of his old 811 pat-

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[8]For example, in response to the Patent Examiner's original rejection of all of the claims of his improvement patent as anticipated by his old 811 patent Graham's counsel argued as follows:

"At the first of the interviews the Examiner's rejection of the claims on applicant's patent was discussed. It was pointed out that the present construction is an improvement over the structure disclosed in applicant's (811) patent. The patented structure has proved a highly commercial success and has made this type of plow satisfactory for substantially all plowing conditions. It was found, however, that wear occurred between the shank and the fixed part of the clamp where the fulcrum shifted from the pin to that portion of the fixed part of the clamp directly at the rear end of the clamping face thereof. It was pointed out that the present construction avoided this wear by inserting the movable part between the plowing shank and the fixed part and by locating the pivot to avoid rubbing contact of the pivoted part with the fixed part of the clamp. With this arrangement the vibratory movement of the shank acted on the pivoted part or shank attaching member of the clamp. This shifting of the wear point to the pivoted part facilitates repair and replacement when wear does occur."

ented structure as now fairly entitles him to prevail on the issue of infringement.[9]

Graham argues, in substance, that the claimed inconsistencies in his various positions before the Patent Office, the district court and this Court, are more illusory than real; that in defensively asserting these alleged inconsistencies Jeofroy is seeking to avoid infringement on a new theory and technical basis by quoting prior statements and arguments in other independent and materially unrelated proceedings out of context, and either according them a binding effect never intended, or interpreting the claimed structural and operational differences between Graham's 811 patent and the teachings of the prior art then relied upon as conclusive against infringement here, when at most the previously asserted distinguishing features were merely some among many which could have been urged to avoid anticipation and establish validity; that, in any event, the omission of these elements in the accused device is insufficient to avoid infringement under the applicable range of equivalents. In view of these insistencies, we have re-examined Graham's arguments on the former appeal, as compared with those now urged by him, but we cannot agree that they are immaterial to his present charge of infringement, or that they do not effectively nullify the force which might otherwise flow from the trial court's finding and his argument that the new Jeoffroy device exemplifies a mere colorable departure in structure and method of operation from his

[9]The trial court apparently had no opportunity in its original decision to consider from this Court's viewpoint the effect of Graham's inconsistent positions as limiting the scope of his 811 claims, since its original letter decision was rendered on the same day as this Court's decision on the former appeal, i.e., September 9, 1953.

811 patent which is insufficient to avoid infringement. (Footnote 2, *supra.*) While we expressly disavow any intimation of actionable bad faith on the part of the patentee, Graham, in assuming positions for the purpose of avoiding anticipation and establishing validity of both his 811 and improvement patent, which appear to us inconsistent with positions now assumed for the purpose of prevailing on the present issue of infringement, we do hold, contrary to, but in the language of the district court, that "the context of the patent, the Patent Office history and the prior art and use" fairly limit and restrict the scope of Graham's monopoly under 811 to a structure wherein the shank is mounted between a fixed part and a moveable part, in "moveable engagement" with each of said parts, and clampingly held thereby; that the prior art, the physical exhibits, the testimony, and this Court's decision on the former appeal,[10] viewed as a whole, fairly establish that the new Jeoffroy structure may not logically be viewed as embracing the essential elements of the 811 patent claims, either literally or by equivalence, and that the trial court's finding of infringement of claims 5 and 6 of the Graham 811 patent may not therefore be sustained. *Cf. Livesay Industries* v. *Livesay Window Co.,* 5 Cir., 202 F. 2d 378, 382. See *Graver Mfg. Co.* v. *Linde Co.,* 339 U. S. 605, 609; *Westinghouse* v. *Boyden*

[10]While it is true that this Court, in its decision on the former appeal, did not expressly restrict the scope of Graham's 811 claims to the precise structure disclosed by the patent, we think the opinion itself fairly evidences this Court's acceptance of Graham's repeated arguments that the essentially novel concept of that invention was "the idea of resilient and frictional engagement of the shank of a ground working tool between a fixed part and a movable part," etc. (See 206 F. 2d 777), and that he may not now extend the scope of his 811 monopoly to embrace the substantially different Jeoffroy structure here claimed to infringe.

Appendix D

Power Brake Co., 170 U. S. 537, 568; *Jungersen* v. *Baden*, 2nd. Cir., 166 F. 2d 807, 809; *Wood* v. *Peerless Motor Car Corp.*, 6th Cir., 75 F. 2d 554, 555; *Southern States Equip. Corp.* v. *USCO Power Equip. Corp.*, 5th Cir., 209 F. 2d 111, 120; *Stewart-Warner Corp.* v. *Lone Star Gas Co.*, 5th Cir., 195 F. 2d 645, 648; *Independent Pneumatic Tool Co.* v. *Chicago Pneumatic Tool Co.*, 7th Cir., 194 F. 2d 945, 947; *Chicago Forging & Mfg. Co.* v. *Bade-Cummins Mfg. Co.*, 6th Cir., 63 F. 2d 928, 929-930.

II. Validity of Graham's Improvement Patent, No. 2,627,798.

The application for Graham Patent No. 2,627,798, hereinafter simply called 798, was filed on August 27, 1951, and the patent issued February 10, 1953. It relates to an improvement of the original structure revealed by Graham's old 811 patent. While it is basically akin to the structure thereby disclosed and described in our former decision (*Jeoffroy Mfg. Inc.* v. *Graham, supra* at pp 773-774), it does exhibit distinguishing structural features in that the pivot pin and fulcrum plate have been relocated above the shank, instead of below the shank as in Graham's old 811 patent, and the fulcrum plate has a stirrup device which supports the shank at a point adjacent the pivot pin. The 798 patented structure also operates on a fixed, rotating pivot instead of the loose, sliding pivot of the old Graham 811 device.

Jeoffroy concedes that Graham's new 798 patent exhibits a divergent structure in the following particulars: (1) the location of the pivot pin above the shank; (2) the short bolt which attaches the shank and shank attaching member to each other at the forward ends thereof; (3) the rearward extending lugs on the fixed mem-

ber and the upward extending lug on the hinge member, through which the pivot pin is inserted to form the pivot; and (4) the downward extending loop or stirrup which embraces the shank at the rear of the shank attaching member. According to Jeoffroy, the sum of the above changes constitutes no more than a manufacturer's modification made for the purpose of reducing operational stress and wear in the basic 811 patent structure, which the trial court correctly viewed as "within the capacity of a skilled mechanic," and therefore lacking in invention.

On the other hand, Graham contends that, while his 798 patent uses "the basic idea of the fulcrum plate and the moveable engagement of the shank," it in effect produces an old result in a more advantageous way by substituting the fixed and rotating pivot, to some extent revealed by prior art devices, for the wear-producing, sliding and shifting pivot of 811, at the same time retaining by means of its particular shank and pivot arrangement substantially that same degree of flexibility and resiliency which was such an advantageous feature of its 811 predecessor; that claims 1 and 2 of 798[11] are not invalid for "double patenting" and lack of invention, as held by the district court, but "clearly specify a particular arrangement and relationship of the parts that is not

[11]We think these two detailed and lengthy claims of Graham's 798 patent, the only ones granted by the Patent Office, need not be set forth in *haec verba* here. Generally, they are directed to the same type improved clamp structure and shank arrangement exhibited by the new Jeoffroy device, though specifically they recite means for maintaining the shank in "constant and continuous contact" with the shank attaching member.

found in the Graham (811) Patent,'"[12] as evidenced by issuance of 798 by the Patent Office after 811 was distinguished as a prior reference; that the claims of 798 further cannot be read upon the structure of 811 either literally or by equivalence; that 798 actually reveals a valid combination and patentable improvement over 811 and the most pertinent other prior art and use,[13] which was beyond conception by an ordinary artisan in the agricultural implement trade; finally, since infringement is admitted, Graham is clearly entitled to the injunctive relief and accounting prayed for.

With commendable candor Jeoffroy further concedes that "its accused structure cannot be distinguished in any material respect from Patent No. 2,627,798"; that "the Trial Court was clearly wrong in concluding that Patent No. 2,627,798 is void as double patenting of the original Graham invention";[14] that no "single prior reference patent or structure anticipates completely the claims of Patent No. 2,627,798" and "the claims will not read on any one of the references because there are

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[12]Compare this argument with Graham's argument on the infringement issue that his 798 patent's twin and counterpart, the new Jeoffroy device, is a structure substantially equivalent to that disclosed by his 811 patent.

[13]A number of the prior art patents and uses principally relied upon as anticipatory of Graham's 798 patent are the same as those previously cited by Jeoffroy in his unsuccessful attempt to upset the validity of 811 on the former appeal (See 206 F. 2d at p. 776), and will not be specifically reviewed in this opinion.

[14]Apparently, consistency and logic compels Jeoffroy's admission in brief that, if the trial court was wrong in its factual finding of equivalence between its new structure and Graham's 811 patent, which he asserts and we have held that it was, then Graham's 798 patent cannot logically be viewed as invalid for "double patenting."

specific differences of structure and of function"; and that "unquestionably Graham's new patent structure is a definite improvement over the old." However, on the issue of anticipation, Jeoffroy does insist that the prior art "as a whole" contains "the storehouse of information from which any skilled workman could draw to effect the changes made by Graham," particularly since a number of the improvements adopted were separately indicated by various prior art devices such as Lamprell, Erdman, Drader, Traeger, Dunbar, Carter, Moore, the Danish patent to Petersen, and the Valley City and supposed Helfeld and McKee prior use devices. See and *cf. Parks* v. *Booth,* 102 U. S. 96, 104, cited with approval in *Jeoffroy Mfg., Inc.* v. *Graham, supra,* at p. 777. On the issue of claimed invalidity *vel non* for lack of invention, Jeoffroy relies mainly on the Supreme Court's landmark decision in *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.,* 340 U. S. 147, apparently the favorite sanctuary of alleged mechanical patent infringers, and vigorously insists that the stricter test of invention there enunciated and adhered to by former decisions of this Court is not met by Graham's 798 patent. See *Ritchie* v. *Lewis Browning Mfg. Co.,* 5th Cir., 196 F. 2d 434, 437; *Graham* v. *Jeoffroy Mfg., Inc.,* 5th Cir., 206 F. 2d 769, 771-772; *Robinson* v. *Di Gaetano,* 5th Cir., 212 F. 2d 1, 3.

Our interpretation of the prior art, the physical exhibits, and the testimony, however, compels us to disagree with the learned district court's conclusion that the 798 patent is invalid, either for "double patenting" or lack of invention. Though we do agree that 798, as an improvement combination, is not entitled to any broad degree of protection over 811, it still seems to us that its hybrid type structure combining the wear-resisting rotat-

ing pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old 811 structure, reveals sufficient indicia of novelty and invention to justify limited protection. See *Southern States Equip. Corp.* v. *USCO Power Equip. Corp., supra* at p. 118. Other factors strongly influencing and, we think reinforcing our conclusion as to the validity of 798 are: (1) that presumption of validity which attends the grant of a patent by the Patent Office where, as here, it appears to have fully considered and distinguished the very prior art patents here principally relied upon as anticipation (*Southern States Equip. Corp.* v. *USCO Power Equip. Corp., supra*); (2) the rule that the burden of proof of invalidity is on the party seeking to upset a patent's *prima facie* validity from issuance, and that any reasonable doubt will be resolved against him,[15] (3) the further rule, long recognized by this Court, that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where, as here, it produces an old result in a cheaper and otherwise more advantageous way;[16] (4) the trial court's findings and Jeoffroy's significant admissions, heretofore quoted, as to the improved efficiency and economy in the 798 structure, as well as the lack of disclosure thereof

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[15]See Title 35 U.S.C.A. Sec. 282; Mumm v. Decker & Sons, 301 U. S. 168, 171, 81 L.Ed. 983, 985; Radio Corp. v. Radio Engineering Lab., Inc., 293 U. S. 1, 7, 8, 79 L. Ed. 163; Hughes Tool Co. v. Robertson Rock Bit Co., Inc., 80 F. Supp. 809 (Aff. 176 F. 2d 783, 5th Cir.).

[16]Robertson Rock Bit Co. v. Hughes Tool Co., 5th Cir., 176 F. 2d 783, 790, 791; Troup, et al. v. Vox, 5th Cir., 133 F. 2d 83; O. K. Jelks & Son v. Tom Huston Peanut Co., 5th Cir., 52 F. 2d 4, 8; Huston v. Barrett, 5th Cir., 23 F 2d 907.

by any single device or group of devices in the prior art; (5) the fact that Jeoffroy himself apparently considered the 798 structure independently patentable over 811 and the prior art, as evidenced by his filing of an application for a patent on its counterpart and subsequent withdrawal thereof only when Graham's 798 patent was issued first; and (6) finally, the fact that the force which might otherwise attach to the eminent trial court's conclusion as to invalidity, insofar as based on testimony by Jeoffroy's witness, Witherspoon, that in his opinion the improvements embodied in 798 were within the capacity of an ordinary skilled mechanic, seems to us considerably weakened by the fact that this witness was admittedly not a patent expert, but only an engineer testifying for his first time in a patent suit.[17] We conclude, therefore, that Graham's 798 patent is not invalid, either for "double patenting" or lack of invention, but exhibits patenable novelty and invention not effectively anticipated by any of the prior art patents or alleged public uses relied upon. See *Mumm* v. *Decker & Sons,* 301 U. S. 168, 171; *Carnegie Steel Co.* v. *Cambria Iron Co.,* 185 U. S. 403; *Robertson Rock Bit Co.* v. *Hughes Tool Co.,* 5th Cir., 176 F. 2d 783, 790-791; *Cline Electric Mfg. Co., et al.,* v. *Kohler,* 7th Cir., 27 F. 2d 638, 641; *Carson* v. *American Smelting & Refining Co.,* 9th Cir., 11 F. 2d 764, 770-772.

In response to Jeoffroy's intimation in brief that Graham's failure to manufacture commercially the device of his 798 improvement patent shows that he was more interested in extending the scope of his old 811 monoply

[17]While we recognize that the weight to be accorded the testimony of this witness was primarily for the trial court, we still believe it is an appropriate fact for our consideration in reviewing the trial court's finding of invalidity in what appears to us a close case.

than in providing the public with an improved spring clamp device, we can only add that our patent laws have generally acknowledged the validity of the maxim, "prior *tempore potior jure,*" regardless of whether a prospective patentee is guided by altruistic motives, and one who permits others to pre-empt him in securing monoply protection for patentable devices must necessarily be confined to the struggle for recognition and success amidst the normal forces of competition, unaided by the impetus of a statutory monopoly which rightfully adheres in another.

On the appeal of Jeoffroy Mfg., Inc., the judgment holding claims 5 and 6 Graham's patent No. 2,493,811 infringed by said Jeoffroy Mfg., Inc. is reversed. On the appeal of William T. Graham, the judgment holding the Graham patent No. 2,627,798 invalid and dismissing the counterclaim as to said patent is reversed. The cause is remanded with directions to enter judgment holding that claims 5 and 6 of Graham's No. 2,493,811 patent are not infringed by the new Jeoffroy structure, but that Graham's No. 2,627,798 improvement patent is valid and infringed thereby, and for further proceedings not inconsistent with this opinion.

REVERSED AND REMANDED WITH DIRECTIONS.

A True Copy:
Teste:

Clerk of the United States Court of
Appeals for the Fifth Circuit.

APPENDIX E

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 16966

JEOFFROY MFG., INC.,
Appellant,

versus

WILLIAM T. GRAHAM,
Appellee.

Appeal from the United States District Court for the Northern District of Texas.

(June 5, 1958.)

Before HUTCHESON, Chief Judge, and TUTTLE and WISDOM, Circuit Judges.

TUTTLE, Circuit Judge: This appeal deals with the Graham patent No. 2,627,798, which is also the subject of an opinion entered today under the name of William T. Graham and *Graham-Hoeme Plow Co.* v. *Cockshutt Farm Equipment Co., Inc.*, 5 Cir., 256 F. 2d 358. It is between the two opponents who have already appeared in this Court in several different cases raising questions as to the validity of this patent and its infringement *vel non* by Jeoffroy.

Appendix E

As we have said in the other case just decided, the able trial judge has become an expert in the art of spring plow clamps of the Graham type. This naturally gives even more weight than is usually to be accorded to findings of infringement by the trial judge, for he has perforce had these very devices before him for days at a time, with the testimony of experts and argument of learned and able counsel, also by now completely steeped in the art, to assist him.

Following our decision in *Jeoffroy Mfg. Co.* v. *Graham*, 5 Cir., 219 F. 2d 511, the District Court enjoined appellant from infringing 798 patent. Subsequently appellee brought contempt proceedings against Jeoffroy for violation of the injunction. The trial court heard evidence and saw a field demonstration and held broadly that several clamps manufactured and sold by Jeoffroy infringe the Graham patent.

The real crux of the case arises from an attempt by Jeoffroy to modify its clamps which had previously been adjudicated to be infringement, by giving them characteristics which Graham testified were identified with the prior art and the departure from which afforded Graham protection in his patent.

Specifically, Graham claimed in support of his 798 patent that when the shank was forced upward against the force of the spring his 798 patent was the first arrangement of parts that permitted lateral, vertical and longitudinal flexibility of the shank without undue wear on the parts. This he accomplished by leaving some space at the first point and by having the bolt at the front end in a hole somewhat larger than the size of the bolt itself. This afforded a firm connection without rigidity and permitted longitudinal motion and a flexing of the

shank. Graham pointed out that the prior art taught only rigid fixation of the shank at the pivot point and at the forward end.

What Jeoffroy did, then, was to suspend the shank at the pivot point in a stirrup, with sufficient room for vertical movement, but he then, according to his testimony, undertook to eliminate this movement by the insertion of a set screw, which if tight, would, in fact, prevent the flexibility which Graham insisted was the principal end sought in his invention.

Graham alleged, and the court found, that when the Jeoffroy device was in use the flexibility remained. This was demonstrated by the field experiment and by motion pictures of the Jeoffroy clamp with the set screw in action. The picture was also viewed by us. It was plain that, whatever may have been intended or desired by the insertion of the set screw, in actual operation nothing used in the Jeoffroy modification prevented his clamp from operating in the same manner as does the Graham clamp. Since Jeoffroy admitted that "the literal words of both claims of the 798 patent can be read upon the Jeoffroy structures" and since Jeoffroy uses the substance of the Graham invention, the court found in favor of the patentee in the contempt proceedings.

The language used by the trial court states clearly the basis for its findings and it is adopted by us in holding that these findings are supported by the evidence and may not be set aside as clearly erroneous:

"3.

"In adopting said variants, Plaintiff was acting in good faith to the extent that it actually thought that certain contentions and arguments of Defendant's counsel

during previous patent litigation between the same parties had opened the door for Plaintiff to make some distinguishing modifications in its clamp structure by using set screws and bolt fastenings to attain rigid fixation of the shank adjacent the pivot point, and thereby gain protection for its spring clamp against any charge that same infringed the Defendant's patent.

"4.

"The set screw and bolt fastenings provide a rigid fixation of the shank adjacent the pivot point as long as the set screws or nuts are tight and when in that condition the action of the shank in the forward end is in degree materially different from that provided for in the patent structure. Furthermore, the set screw and bolt fastenings adjacent the pivot point provide a structure which is as rigid at that point as any of the prior art references except those in which the shank is welded to the pivot member. However, the arrangement and relative positioning of the members in operation is different than the prior art references and result in flexibility not possible therein.

"5.

"Jeoffroy placed decals on its plows advising the farmers to keep nuts thereon tightened at all times, but it has no reasonable expectation, despite the formality of its decals, that clamps of the Plaintiff's types would actually be used by farmers with a really rigid fixation of the shank at the pivot point, for such structures, to begin with, were adapted to easy and simple manipulation by removing or loosening set screws and loosening or reversing the bolted straps, or, at any rate, same pre-

dictably would become loosened from the play of strong forces during the normal rough usage of the clamps, as borne out by the proof that many farmers using the Jeoffroy equipment in rocky land were found with set screws and bolts loosened or missing, and with fully as much play between the shank and the stirrup as would be typical of the Graham structure in Patent 798. Evidently, the farmers using the Defendant's clamp generally must have liked it better in operation with some motion and play near the pivot point and habitually disused the set screws and bolted straps in tight position in favor of more latitude of motion for the shank.

"6.

"Since it was predictable at the time these modifications were adopted by the Plaintiff that they would not insure a really rigid fixation of the shank at the pivot point and would not eliminate the similar flexibility, as found in the Graham shank, such modifications did not change the real operation of its clamp, and, therefore, did not avoid infringement."

The judgment is affirmed.

APPENDIX F

IN THE

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 16955

WILLIAM T. GRAHAM and GRAHAM-HOEME PLOW CO., INC.,

Appellant,

versus

COCKSHUTT FARM EQUIPMENT, INC.,

Appellee.

Appeal from the United States District Court for the Northern District of Texas.

(June 5, 1958.)

Before HUTCHESON, Chief Judge, and TUTTLE and WISDOM, Circuit Judges.

TUTTLE, Circuit Judge: This is an appeal from a judgment of the trial court finding the Graham Patent No. 2,627,798, "Clamp for Vibrating Shank Plows" valid but not infringed. There is no cross appeal by appellee from the finding of validity of the patent, but appellee contends this issue is still open for review under our recent decision in *Guiberson Corp.* v. *Equipment Engineers, Inc.*, 5 Cir., F. 2d.

Appendix F

This patent is not a stranger to this Court, it having been the subject of an opinion in which we reversed the trial court's finding that it was invalid. *Jeoffroy Mfg. Co., Inc.* v. *William T. Graham,* 5 Cir., 219 F. 2d 511. It is also the subject of another decision which comes up on a citation by Graham for contempt of the trial court's injunction against infringement by Jeoffroy Mfg., Inc. in a case decided simultaneously herewith. We think it unnecessary, therefore, to make a detailed description of the patent except as it is germane to our discussion of the alleged infringement.

We agree with appellee that this Court still has the power to change its position as to the validity of the Graham patent No. 2,627,798, even though we have previously held it valid, because the alleged infringer here is a different party and is not bound either by *res judicata* or estoppel by judgment. We also agree that this question is open to us on appeal, even though no cross appal was taken from the Court's judgment in favor of validity. See *The Guiberson Corp.* v. *Equipment Engineers, Inc., supra.* We conclude, however, after careful consideration, that our decision previously made as to the validity of this patent should stand. We, therefore, turn to the question of infringement. In upholding the validity of this patent we said:

> ". . . . Though we do agree that 798, as an improvement combination, is not entitled to any broad degree of protection over 811, it still seems to us that its hybrid type structure combining the wear-resisting rotating pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old 811 structure, reveals

sufficient indicia of novelty and invention to justify limited protection . . ." *Jeoffroy Mfg. Co.* v. *Graham*, 219 F. 2d 511, 518, 519.

Thus, we indicated that being a combination patent in a crowded art, the patent would likely not have wide application.

In essence the patent, relating to a ground-working tool designed with springs to make possible the operation of the plow over rocky ground because of ability of the chisel end of the tool to rise over the rocks it encounters, embodies the combination of elements that permit the shanks of the plows upon striking obstructions, to rise and flex within permissible range of movement.

As the combination, not the result, is what is patented, obviously not every arrangement of elements that achieves the same degree of movement and flexibility is an infringing device. Infringement exists only if the patentee's arrangement is copied, or if, by use of equivalents, the same arrangement is used except that for some element of it equivalents are substituted.

As pointed out above, no part of this device is itself patented or subject to patent, since every one of the parts is old, and its use *independently* in the present combination is a long known use. It is only because this particular arrangement of these known elements adopted by Graham achieves the result better than the prior art afforded that Graham was entitled to a patent.

Thus, if appellee has also achieved good results in permitting movement and flexibility in the action of the shank, but has done so not by using either the known elements used by this patentee in its arrangement, nor by using equivalents as a substitute for any or all of the

elements, but by using different means, there is no infringement.

The able and experienced district judge who presided at the trial of this case may now well qualify as an expert in this art. He has presided at some half dozen trials in which the Graham device has been thoroughly explored. He has also been exposed to the explanations of many allegedly infringing devices in these trials. He has found in this case that the Cockshutt device does not infringe the Graham patent.

In its order the Court explained its conclusion in a manner which, while probably not understandable to the person uninitiated in the art, is perfectly plain to those who have worked so long in this field:

> "Plaintiffs have admitted that Defendant's clamp of the type identified as Plaintiffs' Exhibit No. 3 does not infringe said Patent 798. Moreover, neither claim of the patent can be literally read upon Defendant's clamp of the type identified as Plaintiffs' Exhibit No. 4, Defendant's spring clamp, as exemplified by said Exhibit, has a plate between the shank and fixed member of the clamp, but the plate does not have a shank embracing portion thereon, the plate rocks against a portion of the fixed member instead of being pivoted on a pivot pin, and the forward ends of the plate and shank are not held together by a bolt and nut, and in these, as well as other respects, differs sufficiently from the limited equivalency range of the said Patent 798 so as to avoid infringement of the claims in said patent."

While not the experts in the field that Judge Dooley is, we comprehend and approve the analysis made by him.

Appellee here concedes the law to be "that a patent

is entitled to a range of equivalents commensurate with the scope of the invention." However, it contends for the further proposition that a patent for a limited improvement in a crowded art is entitled to an "extremely" limited range of equivalents, citing *Electrical Protection Co.* v. *American Bank Protection Co.*, 8 Cir., 184 F. 916, and this Court's opinion in *Dry Hand Mop Co.* v. *Squeeze Ezy Mop Co.*, 5 Cir., 17 F. 2d 465. Cf. *Stewart-Warner Corp.* v. *Lone Star Gas Co.*, 5 Cir., 195 F. 2d 645; *Butex Gas Co.* v. *Sou Steel Co.*, 5 Cir., 123 F. 2d 954.

As previously pointed out in the quotation from our opinion upholding the validity of this patent, this improvement combination "is not entitled to any broad degree of protection," and the invention "justifies limited protection." We must bear this in mind in considering the range of equivalents.

Bearing in mind also that the patent does not protect against all combinations that permit a smooth and workable operation of the shank when it is forced upward by striking a hard object and the operation of the spring to force it back into position, but only the particular combination used by Graham, we agree that the fact that the shank and the plate attached to it rock against a portion of the fixed member instead of rotating on a pivot pin, and the fact that the plate and shank are not held together rigidly at the forward end by a bolt, constitutes sufficient departure from the claims and structure of the Graham device to support the trial court's finding against infringement.

The judgment is affirmed.

APPENDIX G

CONSTITUTION, STATUTES AND RULES INVOLVED.

CONSTITUTION

Article I, § 8, Clause 8

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; * * *.

STATUTES

Title 35 U. S. C.

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Appendix G

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party establishing it. * * *.

FEDERAL RULES OF CIVIL PROCEDURE

Rule 52. Findings by the Court.

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusion of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a matter, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41 (b).